

Applicants: Norberto Oscar GOMEZ et al.  
Application No. 10/705,502

## REMARKS

Claims 1-10 and 12-35 are currently pending. Claims 1, 13 and 27 are presently amended to incorporate the subject matter of claim 11, and claim 11 is cancelled. No new matter is added.

The Office Action rejected all pending claims over cited prior art. Applicants traverse the rejections, and light of the preceding amendments and the following arguments, request that the rejections be withdrawn.

### Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,996,824 to Grant ("Grant")

The Office Action rejected claims 1-6, 8, 13-21, 27-33 and 35 as anticipated by Grant. Independent claims 1, 13, and 27 have been amended to recite an elongated container nose comprising a nose member tapering from a first diameter to a second diameter at an end distal to the container sidewall, the second diameter being smaller than the first diameter. Support for the amendment can be found in original claim 11 and in the Figures.

In light of the amendment to claims 1, 13 and 27 incorporating the limitations of claim 11, Applicants submit that this rejection is now moot. Grant does not disclose the required claim limitation of an elongated nose comprising a nose member tapering from a first diameter to a second diameter at an end distal to the container sidewall, the second diameter being smaller than the first diameter. Accordingly Grant does not anticipate amended independent claims 1, 13 and 27. All of the limitations of amended independent claims 1, 13, and 27 are incorporated into the dependent claims. Therefore, for at least the reasons stated above, Grant also does not anticipate dependent claims 2-6, 8, 14-21 and 28-33 and 35. Withdrawal of the

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rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(b) over U.S. Patent No. 5,046,877 to Longo ("Longo") in view of Grant

The Office Action rejected claims 1-6 and 8-35 as unpatentable over the combination of Longo in view of Grant. Applicants respectfully traverse the rejection. It is well established that "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143 - § 2143.03

First, Applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine the refill container of Grant with the caulk tube of Longo. Longo is directed to a coating dispenser cartridge having a guide along the nozzle and near the tip. The guide facilitates proper positioning of the nozzle and therefore contributes to uniform application of the substance along the surface to coated. The device of Longo is intended for dispensing a viscous, plastic flowable substance such as a caulking compound, sealant, adhesive, or other viscous substance. In contrast, Grant is directed to a double orifice

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container for storing flowable contents such as liquid or powder, to be dispensed, for example, in a "shower-like" manner (Grant, col. 7, lines 54-56). A top dispensing orifice, or full opening is used to dispense the contents. Neither Longo nor Grant contains any teaching or suggestion of their combination; the references are directed to the storing and dispensing of markedly difference materials. Accordingly, a person of skill in the art would not be motivated to combine Longo's guided caulk tube with Grant's double orifice container with tear tab for flowable contents.

Second, even if Longo and Grant were combined, there is no reasonable expectation of success. For example, the orifice of Grant could not be expected to properly dispense a viscous substance such as a caulking compound. This is because Grant is designed for liquid or powder substances that are readily flowable, and there is no suggestion within the Grant reference of using the device for dispensing and applying a viscous substance. Similarly, there is no expectation that a device as disclosed in Longo for dispensing and applying a viscous substance could be successfully modified by combination with a device for dispensing flowable powders and liquids. For instance, such a readily flowable substance would quickly pour out of the opening of Longo and prevent the desired precise, controlled application of the substance. Applicants further submit that the combination of Grant and Longo in the manner asserted by Office Action would not be successful because it would not be practical or possible to incorporate the tear tab assembly of Grant with the spout of Longo. As disclosed by Grant, the tear tap flap 25 is permanently welded to the dispensing cap 11 (Grant, col. 11, lines 28-29). Applicants note that the flap 25 is present between the cap and its lid. The spout of Longo does

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not have a hinged lid, but an end portion 56 that must be cut off to dispense contents. It is not clear how the tear tab assembly of Grant could be integrated with the tip of Longo. For at least these reasons, Applicants assert that the combination of Grant and Longo would not be successful one, and that the second criteria for a *prima facie* case of obviousness has not been met.

Applicants emphasize that the teaching or suggestion of the combination and the reasonable expectation of success of the combination must be found in the references, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It appears that the Office Action is using the present application as guide from which to selectively choose components from the prior art. It is respectfully submitted that this method of combining references amounts to an improper use of hindsight. The Federal Circuit has ruled, "Prior art may not be gathered with the claimed invention in mind." *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766, (Fed. Cir. 1985), citing *In re Antle*, 444 F.2d 1168, 170 USPQ 285, (CCPA 1971). Further, "[i]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Werner Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) citing *In re Rouffet*, 149 F.3d 1350, USPQ2d 1453, (Fed. Cir. 1998). Lastly, "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Because the at least the first two criteria required for establishing a *prima facie* case of

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obviousness have not been satisfied, Applicants respectfully submit that the Office Action has not met the burden of establishing a *prima facie* case of obviousness. Therefore, a rejection under 35 U.S.C. § 103 is improper and claims 1-6 and 8-35 are patentable over the applied references as combined in the Office Action. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(b) over 5,046,877 to Longo ("Longo") in view of Grant and further in view of U.S. Patent 6,673,301 to Cargile ("Cargile")

The Office Action rejected claim 7 as unpatentable over the combination of Grant in view of Longo and further in view of Cargile. Applicants respectfully traverse the rejection. For the reasons set forth above, the combination of Longo and Grant does not teach the present invention. The addition of Cargile does not remedy this deficiency. Therefore, claim 7 is patentable over the combination. Withdrawal of the rejection is respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the

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allowability of claims 1-10 and 12-35 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

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